

## REMARKS

In response to the Office Action mailed November 20, 2006, Applicants respectfully request reconsideration of the Application in view of the foregoing Amendments and the following Remarks. The claims as now presented are believed to be in allowable condition.

Claims 2, 12, and 22 have been canceled, and claims 1, 3, 4, 11, 13, 14, 21, 22, 23, and 24 have been amended. Claims 1, 3-11, 13-21, and 23-24 remain in this application, of which claims 1, 11, and 21 are independent claims.

### **Rejection of Claims 1, 5, 6, 9, 10, 11, 15, 16, and 19-21 under 35 U.S.C. §102(b)**

Claims 1, 5, 6, 9, 10, 11, 15, 16, and 19-21 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,219,316 to Buechler et al. (hereafter referred to as "Buechler"). Applicants respectfully traverse this rejection.

Claims 1, 10, and 21 have been amended to recite that the displacement of the side beam from the main beam is an average LCM (least common multiple) that is an average of a first LCM (least common multiple) and a second LCM (least common multiple). The first LCM (least common multiple) is a first integer multiple of a first track pitch for a first one of the disc formats, and the second LCM (least common multiple) is a second integer multiple of a second track pitch for a second one of the disc formats. In addition, the first LCM is within a first tolerance range from the average LCM for the first disc format, and the second LCM is within a second tolerance range from the average LCM for the second disc format.

Support for such limitations of amended claims 1, 10, and 21 is stated at page 11, line 4 to page 12, line 4 of the Present Application:

Referring to the tables of Figs. 14 and 15, the respective odd integer multiple of the respective track pitch is within such a respective servo tolerance range from the

average LCM for each row of the table of Fig. 14. For example, in the first row of Fig. 14, the respective odd integer multiple,  $5*TP1$ , for the DVD ROM/R,RW format is 1.85 which is within the respective servo tolerance range of  $\pm 0.082\mu\text{m}$  from the average LCM of 1.8475. Similarly in that first row, the respective odd integer multiple,  $3*TP2$ , for the DVD RAM format is 1.845 which is within the respective servo tolerance range of  $\pm 0.137\mu\text{m}$  from the average LCM of 1.8475.

....

In this manner, the average LCM value in the table of Fig. 14 is used for the LCM distance between each of the side beams and the main beam in the system 220 of Fig. 11. Thus, the positional phase shift between each of the side beams and the main beam is within the servo tolerance range for stable operation of the tracking servo 238 for the desired multiple disc formats of the optical disc 222.

In contrast, FIG. 2 of Buechler just shows the side beams E and F being displaced from the main beam M by just a *selected one*  $(3/4)*P2 = 1.2\mu$  of the common multiples  $(7/4)*P1$  and  $(3/4)*P2$ . Thus, Buechler does not even remotely mention using *an average* of the first and second common multiples  $(7/4)*P1$  and  $(3/4)*P2$ .

Anticipation of a claimed invention requires the presence in a single prior art document of *each and every* element of the properly construed claim. The Federal Circuit has set out the following requirements for anticipation pursuant to 35 U.S.C. §102:

...that a patent claim is anticipated under 35 U.S.C. §102 "must demonstrate, among other things, identity of invention." ...[O]ne who seeks such a finding must show that each element of the claim in issue is found, either expressly or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.

Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565 (Fed. Cir. 1992).

Because Buechler does not disclose, teach, or suggest all of the limitations of amended claims 1, 11, and 21, the rejection of claims 1, 11, and 21 under 35 U.S.C. §102(b) in view of Buechler should be withdrawn.

Claims 5, 6, 9, and 10 which depend from and further limit claim 1, are allowable for at least the same reasons that claim 1 is allowable as stated above.

Claims 15, 16, 19, and 20 which depend from and further limit claim 11, are allowable for at least the same reasons that claim 11 is allowable as stated above.

**Rejection of Claims 2-4, 7, 12-14, 17, and 22-24 under U.S.C. §103(a)**

Claims 2-4, 7, 12-14, 17, and 22-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Buechler in view of U.S. Patent No. 5,303,216 to Shinoda.

Claims 2, 12, and 22 have been canceled.

Claims 3, 4, and 7 which depend from and further limit claim 1, are allowable for at least the same reasons that claim 1 is allowable as stated above.

Claims 13, 14, and 17 which depend from and further limit claim 11, are allowable for at least the same reasons that claim 11 is allowable as stated above.

Claims 23 and 24 which depend from and further limit claim 21, are allowable for at least the same reasons that claim 21 is allowable as stated above.

**Rejection of Claims 8 and 15 under U.S.C. §103(a)**

Claims 8 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Buechler in view of U.S. Patent No. 5,363,358 to Yanagawa.

Claim 8 which depends from and further limits claim 1, is allowable for at least the same reasons that claim 1 is allowable as stated above.

Claim 15 which depends from and further limits claim 11, is allowable for at least the same reasons that claim 11 is allowable as stated above.



Conclusions

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. Please feel free to contact the undersigned should any questions arise with respect to this case that may be addressed by telephone.

Respectfully submitted,  
for the Applicant(s)

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CERTIFICATE OF MAILING

The undersigned hereby certifies that the foregoing AMENDMENT AND RESPONSE is being deposited in the United States Postal Service, as first class mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16th day of February, 2007.

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